

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

In re Application of:)	Method of Generating Revenue
)	From the Right To Display
BRADLEY EMALFARB)	Advertising Information...
)	
)	Examiner: Alvin L. Brown
Serial No. 10/601,390)	
)	Group Art Unit 3622
Filed: June 23, 2003)	

APPELLANT'S BRIEF ON APPEAL

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

REAL PARTY IN INTEREST

The real party in interest is the individual, sole inventor, Bradley Emalfarb.

RELATED APPEALS AND INTERFERENCES

No other prior or pending appeals, interferences, or judicial proceedings are known to Appellant, the Appellant's legal representative, or the assignee which may be related to, directly affect, or be directly affected by, or have a bearing on, the Board's Decision in this pending appeal.

STATUS OF CLAIMS

Claims 1-22 are pending and at issue. Claims 1-22 stand rejected under 35 U.S.C. § 101 as allegedly directed to non-statutory subject matter. Claims 1-13 and 15-22 stand rejected under 35 U.S.C. § 103 as obvious over U.S. Patent No. 6,897,786,

to Kalt et al. (Kalt), in view of U.S. Patent No. 4,015,349 (Dunne) and further in view of the *New York Times* article written by Matthew Purdy ("Turnpike"). Claim 14 stands rejected under 35 U.S.C. § 103 as obvious over Kalt in view of Dunne and Turnpike, and further in view of U.S. Patent No. 6,267,529, to Mudryk et al. (Mudryk).

The Final rejection of all pending claims 1-22 is being appealed herein.

STATUS OF AMENDMENTS

No Amendment was filed following the February 23, 2011 Final Office Action.

SUMMARY OF CLAIMED SUBJECT MATTER

In the Evidence Appendix, copies of pages from the Detailed Description are included incorporating amendments made thereto during prosecution. Summarizing the language of independent claims 1 and 13, reference will be made to the original Description as well as to the amended Description in the Evidence Appendix, wherein underlining has been used to identify the added language.

Independent Claim 1

Claim 1 is directed to a method of generating revenue from the right to display advertising information on or adjacent to a public right-of-way 10. Only one of the several different disclosed methods is described below with respect to claim 1. The methods are distinguishable in one respect by reason of the location of a support for viewable information, shown at: a) 44(adjacent to lanes 12, 14); b) 119 between lanes

14, 18; c) 69 spanning lanes 12, 14; and d) 89 spanning lanes 12, 14, 18, 20.

Exemplary support 44 will be the focus of the description in claim 1.

The support 44 is provided on or adjacent to a public right-of-way 10 that is maintained and/or regulated by a federal or local authority. (See Figs. 1 and 5; pg. 9, lines 10-17 and corresponding portions of the Evidence Appendix, and pg. 14, line 21.) The public right-of-way 10 includes at least one lane 12, 14 for vehicle traffic to move in a first direction and a second lane 18, 20 spaced to a side of the one lane for vehicle traffic to move in a second direction oppositely to the first direction. (See Fig. 1 and pg. 8, lines 15-20.)

A first type of information 56 is provided on the support 44. The first type of information 56 is placed by the federal or local authority that maintains and/or regulates the public right-of-way and is of a nature that is conventionally placed by federal or local authorities that maintain and/or regulate public right-of-ways to aid the navigation of vehicles on the public right-of-way. (See Figs. 1 and 5; pg. 9, lines 14-20 and corresponding portions of the Evidence Appendix, and pg. 14, lines 21 and 22.) The first type of information 56 is placed in a manner that the first type of information 56 is viewable by an occupant of a vehicle in one lane 12, 14 moving in a first direction and facing generally in the first direction. (See Figs. 1 and 5 and pg. 9, lines 21-24.)

Advertising information 62, that is a different type than the first type of information 56, is placed on the support 44 for an entity that is not the federal or local authority that maintains and/or regulates the public right-of-way so that the advertising information 56 is viewable by an occupant of a vehicle moving in the second direction in one of the lanes 18, 20 and facing in the second direction. (See Figs. 1 and 5; pg. 10,

lines 5-10 and corresponding portions of the Evidence Appendix, and pg. 14, lines 22 and 23.)

A fee is charged to the entity to allow the advertising information to be maintained on the support 10 by the entity. (See Fig. 5 and pg. 14, lines 23 and 24.)

Independent Claim 13

Claim 13 is directed to a method of generating revenue from the right to display advertising information on or adjacent to a public right-of-way 10. Exemplary support 44 will be the focus of the description in claim 13.

A support 44 is provided at or adjacent to a public right-of-way 10 that is maintained and/or regulated by a federal or local authority. (See Figs. 1 and 5; pg. 9 lines 10-17 and corresponding portions of the Evidence Appendix, and pg. 14, line 21.) The public right-of-way includes first and second lanes 12, 14 for vehicle traffic to move in one direction and third and fourth lanes 18, 20 to one side of the first and second lanes 12, 14 for vehicle traffic to move in a second direction opposite to the one direction. (See Fig. 1 and pg. 8, lines 15-20.)

A first display system 52 is provided on the support 44 and has a first type of information 56 thereon placed by the federal or local authority that maintains and/or regulates the public right-of-way 10 and is of a nature that is conventionally placed by federal or local authorities that maintain and/or regulate right-of-ways to aid the navigation of vehicles on the public right-of-way. (See Figs. 1 and 5; pg. 9, lines 14-20 and corresponding portions of the Evidence Appendix, and pg. 14, lines 21 and 22.) The first type of information 56 is viewable from a first vantage point.

A second display system is provided on the support 44 for an entity that is not the federal or local authority that maintains and/or regulates the public right-of-way and has advertising information thereon that is a different type 62 than the first type of information 56 and is substantially unviewable from the first vantage point. The first type of information is viewable from a second vantage point. (See Figs. 1 and 5; and pg. 9, lines 21-24.)

The first type of information 56 is viewable by an occupant of a vehicle moving in the one direction in one of the first and second lanes 12, 14 and facing in the one direction. (See Fig. 5 and pg. 9, lines 21-24.)

The advertising information 62 is viewable by an occupant of a vehicle moving oppositely to the one direction in one of the third and fourth lanes 18, 20 and facing oppositely to the one direction. (See Fig. 1 and pg. 10, lines 11-14.)

A fee is charged to the entity to allow the advertising information to be maintained on the support by the entity. (See Fig. 5 and pg. 14, lines 23 and 24.)

GROUND OF REJECTION TO BE REVIEWED ON APPEAL

Ground No. 1

Whether claims 1-22 are properly rejected under 35 U.S.C. § 101 as directed to non-statutory subject matter.

Ground No. 2

Whether claims 1-13 and 15-22 are properly rejected under 35 U.S.C. § 103 as obvious over Kalt in view of Dunne and Turnpike.

Ground No. 3

Whether claim 14 is properly rejected under 35 U.S.C. § 103 as obvious over Kalt in view of Dunne and Turnpike, and further in view of Mudryk.

ARGUMENT

Ground No. 1

Claims 1-22

At the time that the Examiner Finally rejected claims 1-22 under 35 U.S.C. § 101, the law was in a state of transition following the Supreme Court's ruling in *Biisky*. The Examiner's rejection is patterned after the Patent Office guidelines then in place. Since that time, the law has evolved significantly.

The Supreme Court identified three different subject matter areas that are not patent eligible: 1) laws of nature; 2) physical phenomena; and 3) abstract ideas. The issue at hand is whether the claimed subject matter is directed to an "abstract idea".

Chief Judge Rader, in the case *Research Corporation Technologies, Inc. v. Microsoft Corporation*, 627 F.3d 859 (CAFC 2010), set forth the Court's position regarding subject matter that is considered to be an "abstract idea".

Judge Rader's instructive language is as follows:

With that guidance, this Court will also not presume to define "abstract" beyond the recognition that this disqualifying characteristic should exhibit itself **so manifestly** as to override the broad statutory categories of eligible subject matter and the statutory context that directs primary tension on the patentability criteria of the rest of the Patent Act (at pg. 868, our emphasis).

Appellant respectfully submits that the claimed method has no disqualifying characteristic that manifestly exhibits itself so as to be ineligible for patent protection.

Each of the claims at issue requires the utilization of a support upon which specific types of different information are placed for selective viewing, depending upon the vantage point of the user. The vantage point is determined in most of the claims by the particular direction a viewer passes in a vehicle on a right-of-way.

With this arrangement, previously unused space on potentially existing signage can be exploited to generate income without a significant financial investment on the part of the controlling entity and without adversely affecting the normal operation of the roadways or the creation or maintenance of signage thereon.

Accordingly, it is respectfully submitted that the rejection of claims 1-22 under 35 U.S.C. § 101 is improper.

Ground No. 2

Independent Claim 1

Claim 1, which is in method form, utilizes a support on or adjacent to a public right-of-way that has first information thereon that is of a type normally placed by federal or local authority to aid navigation of vehicles on the public right-of-way. The information is viewable by an occupant of a vehicle moving in a lane designed for flow in a first direction. Advertising information, that is a different type than the first type of information, is placed on the support so as to be viewable by an occupant of a vehicle moving in a lane designed for flow in a direction opposite to the first direction. By

charging an entity to maintain the advertising information on the support, revenue is generated.

On page 3 of the Action, in lines 17 and 18, the Examiner states that "... Kalt discloses a method of generating revenue from the right to display advertising information on or adjacent to a public right-of-way...".

The Examiner does not cite any portion of Kalt that allegedly is directed to a corresponding revenue generation associated with the signage therein. A reasonable reading of Kalt is that Kalt is teaching only the enhancement of conventional traffic signs, as used for navigational purposes, to make them more eye-catching and obvious, potentially to introduce safety.

In the last full paragraph in column 2 of Kalt, Kalt references commercial advertising technology and the "striking" appearance thereof as compared to conventional traffic signage, referenced in the preceding paragraph, that is dull to the point that it may not be observed.

Essentially, Kalt is proposing to use existing advertising technology for traffic signs to make them more observable. However, while Kalt compares navigational and advertising technology, Kalt does not propose marrying the two in any manner such as in Appellant's claimed method.

Further, it is respectfully submitted that the Examiner's starting premise that Kalt discloses a method of generating revenue from the right to display advertising information on or adjacent to a public right-of-way is not supported by Kalt's disclosure.

The Examiner relies upon Dunne for the disclosure of information “maintained and/or regulated by a federal or a local authority” (see pg. 4 of Action, lines 9 and 10).

However, Appellant certainly does not claim to have devised the concept of developing signage that is maintained by federal or local authorities for navigational assistance. Roadways abound with this signage.

If one combines Kalt and Dunne’s teachings, one would at best visually enhance, as through use of electronics, the appearance of the existing signage for navigational purposes without incorporating any advertising information as required in claim 1.

The Examiner relies upon Turnpike for “providing advertising information that is different type than the first type of information” on a support and “charging a fee” for the advertising rights (see first full paragraph on pg. 5 of the Action).

Turnpike discusses the concept of generating revenue by having a Turnpike Authority erect its own two-sided, advertising only, billboards and renting them to other entities. Turnpike addresses the issue of how such billboards would change the feel of the public roadways and detract from their appearance. With the system in Turnpike, the public might be overwhelmed not only with billboards on **private** properties, but with additional billboards on governmentally-owned properties between the normal signage relating to the right-of-way and the billboards on the private properties.

In essence, the Turnpike author argues against the use of a two-sided advertising billboard and thereby highlights the value of the Appellant’s invention.

First of all, with the claimed invention, advertising information may be placed on existing supports on which there is already information pertaining to the public right-of-way. The method can be practiced without adding any unsightly and obtrusive structure.

Second, one can use the back of the existing signage and space thereon that currently: a) is strategically situated for viewing by vehicular traffic; and b) is not used for any other purpose.

Third, by reason of offering advertising space in conjunction with supports owned and maintained by a governmental entity, that governmental entity can offer to place, change, and maintain an advertising structure for an entity without any significant additional cost or inconvenience to the governmental entity.

Fourth, income can be derived both from a regular "rental fee" as well as fees that may be charged for changing and maintenance of the advertising components for the entity to which they relate.

Appellant does not claim to be the inventor of signage that has information on opposite sides. Rather, what is significant about the claimed invention is the strategic placement of two different types of information that allows utilization of potentially previously unused space on supports for navigational signage, to generate revenue.

In the challenging economic times that currently exist, local governments have seemingly seized every opportunity to generate income from drivers. Revenue generating methods include issuing tickets for traffic violations through more strict enforcement of traffic laws and use of video monitoring equipment to allow tickets to be

issued for various violations that are not observed firsthand by law enforcement personnel.

In spite of the fact that revenue generation is critical in many local governments, to this day signage exists with an unused side and no entity has taken advantage of this opportunity to raise revenue. According to the invention, this unused side of signage can be modified to include advertising information from which a regular and significant stream of revenue can be generated.

By using existing supports that currently carry navigational signage, no additional unsightly structure is required, such as discussed in Turnpike. As noted above, Turnpike's author highlights the problems with introducing two-sided signage that has a dedicated advertising function and requires placement of signage in locations where it previously did not exist.

The inventive method affords a novel opportunity to generate income that is favorable to agencies in charge of the navigational signage, advertisers, and those that must observe the signage.

Significantly, given that Appellant has not invented the concept of two-sided signage, and that is not by itself the crux of the invention, it is not clear how Turnpike, which discloses nothing more than two-sided advertising signage, would motivate one skilled in the art to arrive at the claimed invention.

Kalt and Dunne are concerned with nothing more than conventional one-sided navigational signage. Turnpike discloses two-sided advertising signage. Together, these disclosures do not in any way lead one to the claimed invention.

Independent Claim 13

Claim 13 parallels claim 1 in many respects and is allowable for at least the reasons claim 1 is allowable, as explained above.

Claim 13 additionally recites a first and second display system on the support for the different types of information.

Dependent Claims 2-12

Each of claims 2-12 is based directly or indirectly upon claim 1, is allowable for at least the reasons claim 1 is allowable, and recites additional detail to further distinguish over the applied art.

Claims 15-22

Each of claims 15-22 is based directly or indirectly upon claim 13, is allowable for at least the reasons claim 1 is allowable, and recites additional detail to further distinguish over the applied art.

Ground No. 3

Claim 14

In rejecting claim 14, the Examiner relies upon Mudryk for the disclosure of a display system at least partially over a center median.

Appellant will admit that conventional signage has been placed at that location. However, Mudryk adds nothing further with respect to teaching or making obvious the basic components in claim 13, upon which claim 14 is based.

CONCLUSION

It is respectfully submitted that all of the pending claims are directed to subject matter that is not merely an abstract idea. Further, none of the pending claims is obvious over the art applied by the Examiner. Accordingly, it is requested that the Board reverse the Examiner's rejection of all of claims 1-22.

Respectfully submitted,

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CLAIMS APPENDIX

1. A method of generating revenue from the right to display advertising information on or adjacent to a public right-of-way, the method comprising the steps of:

providing a support on or adjacent to a public right-of-way that is maintained and/or regulated by a federal or local authority, the public right-of-way including at least one lane for vehicle traffic to move in a first direction and a second lane spaced to a side of the one lane for vehicle traffic to move in a second direction oppositely to the first direction;

providing a first type of information on the support, the first type of information placed by the federal or local authority that maintains and/or regulates the public right-of-way and of a nature that is conventionally placed by federal or local authorities that maintain and/or regulate public right-of-ways to aid the navigation of vehicles on the public right-of-way, the first type of information placed in a manner that the first type of information is viewable by an occupant of a vehicle in the one lane moving in a first direction and facing generally in the first direction;

placing advertising information, that is a different type than the first type of information, on the support for an entity that is not the federal or local authority that maintains and/or regulates the public right-of-way so that the advertising information is viewable by an occupant of a vehicle moving in the second direction in one of the lanes and facing in the second direction; and

charging a fee to the entity to allow the advertising information to be maintained on the support by the entity.

2. The method of generating revenue according to claim 1 wherein the step of placing advertising information comprises placing the advertising information on a substantially flat, first display surface facing in the first direction.

3. The method of generating revenue according to claim 2 wherein the step of providing a first type of information comprises providing a first type of information on a substantially flat, second display surface facing oppositely to the first direction.

4. The method of generating revenue according to claim 1 further comprising the step of illuminating the advertising information.

5. The method of generating revenue according to claim 1 wherein the step of providing a first type of information comprises providing a first type of information on a first display surface that is on the support in an elevated position and at least partially directly over the one lane.

6. The method of generating revenue according to claim 5 wherein the step of providing a support comprises providing a cantilevered arm projecting across at least part of the one lane with the first display surface on the cantilevered arm.

7. The method of generating revenue according to claim 1 wherein the step of providing a support comprises providing first and second upright sections with one of the upright sections on one side of the one lane opposite to the second lane and

the other of the upright sections on the side of the second lane opposite to the one lane and a spanning section between the first and second upright sections and extending fully across both the one and second lanes, and the step of providing advertising information comprises providing advertising information on the spanning section.

8. The method of generating revenue according to claim 1 wherein the step of providing a support comprises providing a support that is fully spaced sideways from both of the lanes.

9. The method of generating revenue according to claim 1 wherein the step of providing a first type of information comprises providing a first type of information on a first display surface with a first area on the support, and the step of placing advertising information comprises placing advertising information on a second display surface with a second area on the support so that the first and second areas overlap both sideways and in a vertical direction.

10. The method of generating revenue according to claim 9 wherein the steps of providing a first type of information and placing advertising information comprise situating the first and second areas so that the second display surface is substantially completely obstructed by the first display surface from the perspective of an occupant of a vehicle in the one lane moving in the first direction.

11. The method of generating revenue according to claim 1 wherein the first type of information is provided on a first display system and the advertising information is placed on a second display system and further comprising the steps of providing periodic maintenance to at least one of the support and the first display system, providing periodic maintenance to the second display system in conjunction with the periodic maintenance to the at least one of the support and the first display system, and charging a fee to the entity for the periodic maintenance to the second display system.

12. The method of generating revenue according to claim 1 further comprising the steps of changing the advertising information and charging a fee to the entity for changing the advertising information.

13. A method of generating revenue from the right to display advertising information on or adjacent to a public right-of-way, the method comprising the steps of:

providing a support at or adjacent to a public right-of-way that is maintained and/or regulated by a federal or local authority, the public right-of-way comprising first and second lanes for vehicle traffic to move in one direction and third and fourth lanes to one side of the first and second lanes for vehicle traffic to move in a second direction opposite to the one direction;

providing a first display system on the support and having a first type of information thereon placed by the federal or local authority that maintains and/or regulates the public right-of-way and of a nature that is conventionally placed by federal or local authorities that maintain and/or regulate right-of-ways to aid the navigation of vehicles on the public right-of-way and viewable from a first vantage point;

providing a second display system on the support for an entity that is not the federal or local authority that maintains and/or regulates the public right-of-way and having advertising information thereon that is a different type than the first type of information and that is substantially unviewable from the first vantage point and so that the first type of information is viewable from a second vantage point,

wherein the first type of information is viewable by an occupant of a vehicle moving in the one direction in one of the first and second lanes and facing in the one direction,

wherein the advertising information is viewable by an occupant of a vehicle moving oppositely to the one direction in one of the third and fourth lanes and facing oppositely to the one direction; and

charging a fee to the entity to allow the advertising information to be maintained on the support by the entity.

14. The method of generating revenue according to claim 13 wherein there is a center median between the first and second lanes and the third and fourth lanes, and the step of providing the second display system comprises providing the second display system at least partially over the center median.

15. The method of generating revenue according to claim 13 wherein there is a first shoulder region to a side of the first and second lanes opposite to the one side and the step of providing the second display system comprises providing the second display system at least partially directly over the first shoulder region.

16. The method of generating revenue according to claim 13 wherein the step of providing the second display system comprises providing the second display system spaced to one side of the third and fourth lanes and at least partially directly over the first lane.

17. The method of generating revenue according to claim 16 wherein the step of providing the second display system comprises providing the second display system so that the second display system is not directly over either of the third and fourth lanes.

18. The method of generating revenue according to claim 17 wherein the step of providing a support comprises providing a spanning section extending continuously and fully across the first, second, third, and fourth lanes.

19. The method of generating revenue according to claim 13 wherein the steps of providing first and second display systems comprises providing first and

second display panels, respectively having the first type of information and the advertising information thereon, with substantially the same shape.

20. The method of generating revenue according to claim 19 wherein the step of providing first and second display panels comprises providing first and second display panels having substantially the same size.

21. The method of generating revenue according to claim 13 further comprising the steps of providing periodic maintenance to at least one of the support and the first display system, providing periodic maintenance to the second display system in conjunction with the periodic maintenance to the at least one of the support and the first display system, and charging a fee to the entity for the periodic maintenance to the second display system.

22. The method of generating revenue according to claim 13 further comprising the steps of changing the advertising information and charging a fee to the entity for changing the advertising information.

EVIDENCE APPENDIX

Page 9

The sign systems 30, 38 have the same construction, with exemplary sign system 30 shown in detail in Figs. 2 and 3. The sign system 30 consists of a support at 44 consisting of, in this case, a pair of spaced, vertically extending upright members 46, 48. The upright members 46, 48 could be made of lumber, metal, or any suitable material known to those skilled in the art, and are each suitably anchored in conventional fashion relative to a support surface 50. The upright members 46, 48 cooperatively carry a display system/panel 52 having a flat display surface 54 upon which information 56 of a first type pertaining to the public right-of-way is applied. The first type of information can be the identification of an exit, identification of a highway number, a distance designation, or virtually any type of information that is commonly and conventionally provided on signage on federal and state highways, by those entities that regulate and/or maintain those highways, to aid the navigation of vehicles. Lights 58 are provided on the support 44 to illuminate the information 56 on the display surface 54. The plane of the flat display surface 54 is aligned normally at substantially a right angle to the length of the lanes 12, 14 so as to be readily viewable by an occupant from a vehicle, moving in the direction of the arrow 16 in the lanes 12, 14.

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According to the invention, information, of a type different than the first type, shown generically at 62, is provided on the side 60 of the sign system 30. The information 62 is preferably at least in part unrelated to the public right-of-way. The information 62 may be advertising information placed by individuals or companies, unrelated to the entity or entities that regulate and/or maintain the public right-of-way, relating to a location to which access can be gained via the right-of-way 10 or just general advertising material with no connection to the right-of-way 10.

RELATED PROCEEDINGS APPENDIX

None.